

144-12-0396

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PC

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
: :
KLAUS W. HARTIG, et. al. : Group Art Unit: 1315
: :
Serial No.: 08/486,643 : Examiner: T. Speer
: :
Filed: June 7, 1995 : Atty. Dkt. No.: ^2372.853
: :
For: METHOD OF MAKING HEAT :
TREATABLE, DURABLE, IR- :
REFLECTING SPUTTER-COATED :
GLASSES :
NOV 22 1996

RESPONSE

RECEIVED
COMM-FACENTER

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants wish to express their gratitude to Examiner Speer for the courteous telephone discussion conducted with Applicants' undersigned counsel regarding the manner in which subject situations should be handled.

Turning first to the Office Action, the claims stand rejected either under 35 U.S.C. §101 (or under the judicially created doctrine, both known as) "double patenting." The issue of double patenting, of course, arises herein out of the copendency of this application with Application Serial No. 08/102,281.

That application is, of course, the parent of the subject application and is currently at the Board of Appeals regarding the sole issue of "new matter." Obviously, if the issue of "new matter" is resolved in Applicants' favor, then it is Applicants' intention to seek the cooperation of the Examiner to convert the above-identified subject application to a divisional to cover the unelected invention found in Application Serial No. 08/102,281.

If on the other hand, the Examiner's position prevails at the Board of Appeals (and no further appeal is taken) regarding the issue of "new matter", that application would then become abandoned and the subject application will be the sole application pending (without the "new matter" issue present).


In sum and substance, until the Board of Appeals is able to render an opinion regarding the issue of "new matter" in the parent case, Applicants are caught in a dilemma which, in accordance with the kind suggestions and approval of the Examiner, is resolved by the attached Petition to Stay further prosecution of the subject application pending the outcome from the Board of Appeals in the parent case.

In specific response to the Office Action and in order to be sure that this response is, in fact, responsive thereto, Applicants respectfully request reconsideration of the double

patenting rejections of the claims either under 35 U.S.C. §101 or under the judicially created doctrine of "double patenting." The grounds, therefore, are that as the Examiner has correctly recognized, these double patenting rejections as current made stand only as "provisional" because Applicants have not allowed either of the subject applications in question to issue. It is also apparent from the above-discussion that Applicants have no desire to engage in "double patenting", but rather simply to allow the quasi-judicial processes of the USPTO to proceed to a proper conclusion with all deliberate speed.

Thus, in full response to the rejections, Applicants specifically request reconsideration by way of the attached Petition and the staying of only further rejection of this case pending the outcome of the Board of Appeals decision. Since the rejection is "provisional" there has been no abuse of the patent system through issuance of any patent or is there, obviously, a likelihood thereof. Staying of further prosecution of this case in accordance with the Petition and the granting of the Petition is, therefore, respectfully solicited.

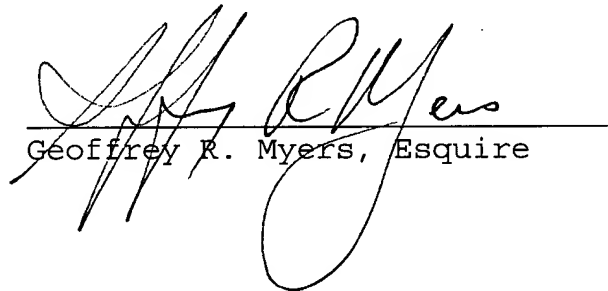
Respectfully submitted,


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I hereby certify that this document is being hand-delivered
to Group Art Unit 1315 at the U.S. PTO on the date shown below.

11-22-96
Date


Geoffrey R. Myers, Esquire